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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,073	10/21/2003	Tokihiro Shimura	4230-101	6700

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/690,073

Applicant(s)

SHIMURA, TOKIHIRO

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/10/06, 10/13/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 and 23-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the proviso “when the powder contains titanium in the absence boron and aluminum, the powder further contains silicon in an amount of **0.8 wt.%**” (see table 1, comparison example 5) does not reasonably provide enablement for the proviso as defined in the independent claims (i.e. when the powder contains titanium in the absence boron and aluminum, the powder further contains silicon in an amount of **at least 0.8 wt.%**). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Although the specification in the table implies a proviso, the only example meeting a powder that contains titanium in the absence of boron and aluminum is comparison 5, and in this comparison, the amount of silicon is 0.8% (specific value), thus the specification only enables the claimed proviso with 0.8 wt% silicon and not **at least 0.8 wt%**, as claimed. In addition, the amount of silicon defined in the tables range from 0.7-1.4%, thus the amount of “**at least 0.8 wt.%**”, as claimed, is not enabled by the specification. Such a limited disclosure does not support the breadth of the instant claims since “**at least**” 0.8 wt% encompasses any and all values above 0.8 wt.% which is not clearly disclosed in the specification.

For the purpose of the instant art rejection, the examiner interprets “composed of” to mean “consisting essentially of”

Claims 1-11 and 23-24 are rejected under 35 U.S.C. 103(a) as obvious over Bergkvist et al. (873) in view of Achikita et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 10/13/06 have been fully considered but they are not persuasive..

With respect to the rejection of claims 1-11 and 23-24 under 35 U.S.C. 112, first paragraph (enabling specification), applicant argues that the amendment to claim 1, 23 and 24, which defines the silicon content as 0.8 wt.%, overcomes this rejection, as 0.8 wt.% silicon is disclosed in the specification. The examiner acknowledges the amendment, however, disagrees with applicant and the rejection stands because the claims define “at least” 0.8 wt.% silicon and the limitation “at least” 0.8 wt.% is not fully supported. The only example that supports the claimed proviso (in terms of the components used) is comparison 5 but the amount of silicon is only 0.8% and not at least 0.8%, thus the specification only enables the claimed proviso with 0.8 wt% silicon (specific value) and not **at least** 0.8 wt%, as claimed. Such a limited disclosure does not support the breadth of the instant claims since “at least” 0.8 wt% encompasses any and all values above 0.8 wt.% which is not clearly disclosed in the specification. Although multiple examples can be used to support a range (upper and lower limit), applicants are not merely claiming a range, but a proviso and it is that proviso, as a whole, that must be

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supported by the specification. The only example that supports the claimed proviso (in terms of the components used) is comparison 5 but the amount of silicon is only 0.8%. The other examples do not support the proviso in terms of the components, thus the examiner is unclear as to how these other examples can be used to support a silicon range if they are not defined in terms of the proviso claimed. Assuming any further arguendo, the examples do not support the broad range of silicon (no upper limit) because the amount of silicon is a definite range, as is apparent from the examples, and this is the only place in the specification that defines silicon.

With respect to the art rejection of claims 1-11 and 23-24, applicant argues this rejection in terms of the 131 declaration filed with the response.

The declaration filed on 10/13/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the previous rejections (insufficient to show reduction to practice prior to the effective date of the reference) for the following reasons.

(1) the declaration does not state where the work was done (it must state that the work was done in the US/NAFTA/WTO country. See MPEP 715.07 (C)).

(2) The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the reference because it does not establish that any and all compositions meeting the claimed criteria were reduced to practice prior to the effective filing date of the reference. The declaration, at most, establishes that specific compositions (ones with specific metal components in specific amounts) were reduced to practice prior to the reference date.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

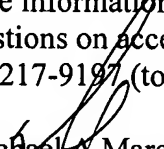
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/07
MM


Michael A. Marcheschi
Primary Examiner
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